

Translation

PATENT COOPERATION TREATY

PCT/EP2003/014582



PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 0000054205	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP2003/014582	International filing date (<i>day/month/year</i>) 19 December 2003 (19.12.2003)	Priority date (<i>day/month/year</i>) 23 December 2002 (23.12.2002)
International Patent Classification (IPC) or national classification and IPC C23C 22/68, C07F 9/09, C07C 235/08, C09J 5/02		
Applicant BASF AKTIENGESELLSCHAFT		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.
2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of _____ sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the report
- II ☐ Priority
- III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand 07 May 2004 (07.05.2004)	Date of completion of this report 11 March 2005 (11.03.2005)
Name and mailing address of the IPEA/EP	Authorized officer
Facsimile No.	Telephone No.

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I. Basis of the report

1. With regard to the elements of the international application:*

- ☒ the international application as originally filed
- ☒ the description:
 pages _____ 1-19 _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☒ the claims:
 pages _____ 1-29 _____, as originally filed
 pages _____, as amended (together with any statement under Article 19
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☐ the drawings:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☐ the sequence listing part of the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language _____ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☐ the claims, Nos. _____
- ☐ the drawings, sheets/fig _____

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

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III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

☐ the entire international application.

☒ claims Nos. 1-15

because:

☐ the said international application, or the said claims Nos. _____
relate to the following subject matter which does not require an international preliminary examination (*specify*):

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. _____
are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. _____ are so inadequately supported
by the description that no meaningful opinion could be formed.

☒ no international search report has been established for said claims Nos. 1-15

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the standard.

☐ the computer readable form has not been furnished or does not comply with the standard.

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Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: III.

**Non-establishment of opinion with regard to novelty,
inventive step and industrial applicability**

Reference is made to the fact that claims for inventions for which no international search has been conducted cannot be the subject of an international preliminary examination (PCT Rule 66.1(e)).

The current claims 1-15 relate to an inordinately large number of possible compounds, of which only a small proportion are supported by the description within the meaning of PCT Article 6 and/or can be regarded as having been disclosed in the application within the meaning of PCT Article 5. In the present case the claims lack the proper support and the application lacks the requisite disclosure to such an extent that it does not appear possible to carry out a meaningful search covering the entire range of protection sought. The search was therefore directed to the parts of the claim that appear to be supported and disclosed in the above sense, namely the parts relating to the compounds as indicated in the embodiments, including closely related homologous compounds. Consequently, only those compounds have been searched in which L is an amide function and X is a group selected from -PO(OH)₂, -PO(OH)(OR), -OPO(OH)₂ or -OPO(OH)(OR).

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V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	23, 24, 26-29	YES
	Claims	16-22, 25	NO
Inventive step (IS)	Claims	23, 24	YES
	Claims	16-22, 25-29	NO
Industrial applicability (IA)	Claims	16-29	YES
	Claims		NO

2. Citations and explanations

Reference is made to the following documents:

D1: US-A-4 202 706 (NEWELL RICHARD G ET AL) 13 May 1980
(1980-05-13)

D2: WO 98/29580 A (METALLGESELLSCHAFT AG; JAEHNE EVELIN
(DE); SEBRALLA LARS (DE); BRAM C) 9 July 1998 (1998-
07-09)

1. The present application does not satisfy the requirements of PCT Article 33(1) because the subject matter of claims 16-22 is not novel within the meaning of PCT Article 33(2).

1.1. Document D1 discloses (the references in parentheses are to D1) the use of compounds of formula $R_F-SO_2-N(R_1)-R_2-PO_3M_2$ for the anticorrosion treatment of Al (claims 1-4). Preferred compounds include 11-(N-ethylperfluorooctanesulfonamide)undecanphosphonic acid and 6-(N-methylperfluorobutanesulfonamido)hexanephosphonic acid (column 2, lines 37-40). The treatment agent contains one or more of the compounds and a solvent or solvent mixture (column 4, lines 36-49). Therefore, the subject matter of claims 16-22 and 25 is not novel.

- 1.2. Reference is made to the fact that claim 22 is not clear. The word "or" is apparently missing between "z¹" and "at least".
2. The present application does not satisfy the requirements of PCT Article 33(1) because the subject matter of claims 26-29 does not involve an inventive step within the meaning of PCT Article 33(3).
 - 2.1. The preparation of compounds in which a metal is first treated with compounds with reactive end groups is a matter of conventional practice in the present field of activity (see e.g. D2, page 6, final paragraph to page 7, first paragraph). A pre-treatment such as is claimed in claim 29 is known from document D1 (column 4, lines 34 and 35; example 9). Therefore, the subject matter of claims 26-29 does not involve an inventive step.
3. The features of dependent claims 23 and 24 do not emerge from the prior art in a manner that is obvious to a person skilled in the art. Therefore, the subject matter of claims 23 and 24 involves an inventive step.
4. The present invention is considered industrially applicable because it can be used in the field of surface treatment.